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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,014	10/20/2003	P. Douglas Kiestler	UC1PAU.24	4115
23386 7590 04/02/2008 MYERS DAWES ANDRAS & SHERMAN, LLP 19900 MACARTHUR BLVD. SUITE 1150 IRVINE, CA 92612				
EXAMINER				
GETTMAN, CHRISTINA DANIELLE				
ART UNIT		PAPER NUMBER		
3734				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/689,014

Applicant(s)

KIESTER, P. DOUGLAS

Examiner

CHRISTINA D. GETTMAN

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-22, 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 11-13 and 23-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in a telephone call made to Daniel Dawes on December 18, 2006.

Claims 1-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 20, 2007.

Applicant's election with traverse of Invention II in the reply filed on February 20, 2007, is acknowledged. The traversal is on the ground(s) that the method and apparatus cannot be separated because references describing methods of use also describe mechanical methods for making the use. This is not found persuasive because the method does not require the particulars of the apparatus. For instance, the method does not require that the device have a handpiece or be used with a catheter. The method, as stated in the restriction requirement, can be performed using a number of different apparatuses including a meat cutter, a saw, etc.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-15, 17, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Shubert et al. (U.S. Patent No. 7,188,628). Shubert et al. disclose the invention as claimed including a method of oscillating a high speed burr including the steps of providing a motor source (ref. 502), connecting the motive source via a drive shaft assembly (col. 5, line 26; ref. 504; ref. 505), oscillating the burr over a portion of a full circle (col. 5, line 60 - col. 6, line 1) at a rate effective for cutting hard matter (the nail) while leaving softer tissue unharmed (col. 4, lines 52-61), providing a burr that is unshielded and fully exposed allowing the cutting to take place in all directions (the user can move the device to any angle and still abrade hard matter (see Fig. 4A and 4B), and converting rotary motion to an oscillating motion (col. 5, lines 26-34 and col. 5, lines 60-61).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shubert et al. in view of Dion (U.S. Patent No. 7,188,628). Shubert discloses the

invention substantially as claimed except for the oscillatory rate (silent on the rate but the device does abrade hard matter), cooling, clearing, and removing debris. Dion teaches a method of oscillating a high speed surgical burr (ref. 18) including the steps of oscillating the burr at a rate to cut hard matter (col. 4, lines 1-3; col. 7, lines 32-33), cooling and clearing the burr by fluid irrigation and fluid (col. 3, lines 28; col. 7, lines 11-16; ref. 118), and removing debris by suction (ref. 96; col. 3, lines 55-58). Therefore, it would have been obvious to have modified Shubert with a high oscillatory rate, as taught by Dion, in order to abrade hard matter and/or bone, fluid irrigation, as taught by Dion, in order to cool and clear the burr of debris, and suction, as taught by Dion, in order to remove the abraded matter from the abrading area. Although Dion discloses having an inner tube rotation rate of, for example, between 100 rpm and 5000 rpm, it would have been obvious to one having ordinary skill in the art to have changed the motor to be able to produce higher rotation speeds, such as those set forth in the claim limitations.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shubert et al. in view of Cattin (U.S. Patent No. 4,536,156). Shubert et al. disclose the invention substantially as claimed except for a slip-clutch. Cattin discloses the use of a slip-clutch (see abstract) for the purpose of rotating of the tool. As shown by Cattin, slip-clutches are well-known in rotary devices to avoid excessive torque build-up. Therefore, it would have been obvious to have modified Shubert with a slip-clutch, as taught by Cattin, in order to aid in rotating a mandrel and avoiding breakage of the tool.

Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shubert in view of Wulfman et al. (U.S. Patent No. 2002/0007190). Shubert et al. disclose the invention substantially as claimed except a telescoping drive shaft and driving shaft. Wulfman et al. teach having an overlapping portion of a drive shaft and driven shaft that are telescopically over each other (see Fig. 3) for the purpose of moving the burr. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Shubert et al. with an overlapping portion of a drive shaft and driven shaft that are telescopically over each other, as taught by Wulfman et al., in order to oscillate the burr to cut bone. The details of the transfer element of Shubert are not disclosed but could be replaced by the system of Wulfman et al. in order to drive the rotational movement of the abrader/burr head.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shubert in view of Dion. Shubert et al. disclose the invention as claimed including a method of oscillating a high speed burr including the steps of providing a motor source (ref. 502), connecting the motive source via a drive shaft assembly (col. 5, line 26; ref. 504; ref. 505), oscillating the burr over a portion of a full circle (col. 5, line 60 - col. 6, line 1) at a rate effective for cutting hard matter (the nail) while leaving softer tissue unharmed (col. 4, lines 52-61), and providing a burr that is unshielded and fully exposed allowing the cutting to take place in all directions (the user can move the device to any angle and still abrade hard matter (see Fig. 4A and 4B). Shubert does not disclose the oscillatory rate (silent on the rate but the device does abrade hard matter), cooling, clearing, and removing debris. Dion teaches a method of oscillating a high speed surgical burr (ref.

18) including the steps of oscillating the burr at a rate to cut hard matter (col. 4, lines 1-3; col. 7, lines 32-33), cooling and clearing the burr by fluid irrigation and fluid (col. 3, lines 28; col. 7, lines 11-16; ref. 118), and removing debris by suction (ref. 96; col. 3, lines 55-58). Therefore, it would have been obvious to have modified Shubert with a high oscillatory rate, as taught by Dion, in order to abrade hard matter and/or bone, fluid irrigation, as taught by Dion, in order to cool and clear the burr of debris, and suction, as taught by Dion, in order to remove the abraded matter from the abrading area. Although Dion discloses having an inner tube rotation rate of, for example, between 100 rpm and 5000 rpm, it would have been obvious to one having ordinary skill in the art to have changed the motor to be able to produce higher rotation speeds, such as those set forth in the claim limitations.

Response to Arguments

Applicant's arguments with respect to claims 14-22 and 26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINA D. GETTMAN whose telephone number is (571)272-3128. The examiner can normally be reached on Monday-Thursday 6:45 am to 4:30 pm (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/
Primary Examiner, Art Unit 3734

/Christina D Gettman/
Examiner, Art Unit 3734
571-272-3128